

REMARKS

1 The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by
Bogert, et al. (5,810,785). Applicant respectfully disagrees with the Examiner's
rejection. However, in an effort to expedite the prosecution of the present matter, claim
5 1 has been amended to define a sealing face on said distal end of the sleeve that is
generally transverse to a long axis of the sleeve. Furthermore, claim 1 has been
amended to state that the gasket is positioned across a substantial portion of the
sealing face on the distal end of the sleeve to permit selective sealing engagement with
the coracoid process when the distal end of said tube is positioned in the glenoid vault.
10 Bogert, et al. fail to teach or otherwise suggest a device with such a structural
arrangement. It is this arrangement that permits a sealing engagement not only
between the tube and the sleeve but also between the sleeve and the bone. The
structural arrangement of the Bogert, et al. device is incapable of performing the
15 procedure for which the present device was designed. Accordingly, claim 1 is believed
to be allowable, since a claim is anticipated only if each and every element as set forth
in the claim is found, either expressly or inherently described, in a single prior art
reference. Verdegaal, Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2
USPQ2d 1051, 1053 (Fed. Cir. 1987).

20 The Examiner is rejecting claim 8 under 35 U.S.C. § 102(b) as being anticipated
by LaBash (5,499,989). Applicant respectfully disagrees with the Examiner's rejection.
However, in an effort to expedite the prosecution of the present matter, claim 8 has
been amended to include a suction mechanism coupled with the proximal end of the
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1 tube. LaBash is a punch-style mechanism that is used to "core" a portion of tissue
using a hollow punch. No suction mechanism is disclosed. Rather, the LaBash
reference teaches away from common biopsy devices using an aspirating needle.
Accordingly, LaBash not only fails to teach the structure as claimed but a person or
5 ordinary skill in the art looking to create the applicant's device would not look, on any
objective basis, to the LaBash reference. Accordingly, claim 8 is believed to be
patentably distinct from the prior art.

The Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as being
unpatentable over Morrey, et al. (5,704,909) in view of Bonutti (5,403,317). The
10 Examiner states that Morrey, et al. disclose a tool having all of the structural limitations
found within claims 1-4 except for a sleeve that is slidably coupled to the exterior of a
suction tube. The Examiner states, however, that Bonutti teaches such a structural
arrangement. The Examiner argues that it would have been obvious to one of ordinary
15 skill in the art at the time the invention was made to combine the Morrey, et al. and
Bonutti references in order to derive the surgical tool as claimed. The applicant
respectfully disagrees.

In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
20 obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
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1 requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984).

5 Claim 1 has been amended to define a sealing face on said distal end of the
sleeve that is generally transverse to a long axis of the sleeve. Claim 1 has also been
amended to state that the gasket is positioned across a substantial portion of the
sealing face on the distal end of the sleeve to permit selective sealing engagement with
the coracoid process when the distal end of said tube is positioned in the glenoid vault.
Neither Morrey, et al. nor Bonutti teach these structural arrangements. Bonutti fails to
10 discuss the use of a face portion on the distal end of its sleeve. Moreover, Bonutti
doesn't teach a sealing engagement between its sleeve and tube. Rather Bonutti
teaches the flow of fluids between the two structures. Accordingly, giving full benefit to
the teachings of both references, the prior art fails to provide the teachings, suggestions
15 or motivations necessary to support a rejection of claims 1-4 under 35 U.S.C. § 103.

The mere fact that the references can be modified does not render the resulting
modified structure obvious unless the prior art also suggests the desirability of the
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
20 been 'well within the ordinary skill in the art at the time the claimed invention was made
because the references relied upon teach that all aspects of the claimed invention were
individually known in the art' is not sufficient to establish a *prima facie* case of

obviousness without some objective reason to combine the teachings of the references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Just because a structural detail is simple and known for other purposes, does not render it "obvious". In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit Court of Appeals decided that the control of multiple valves by a single sensor rather than by multiple sensors was a technologically simple concept. However, the Federal Circuit held that there was no finding as to the specific understanding or principal within the knowledge of the skilled artisan that would have provided the motivation to use a single sensor as the system to control more than one valve. The claimed structural design of applicant's device is an example of such a patentable structure born from a technologically simple concept. More importantly, there is no teaching or suggestion that would render the claimed combination of elements "obvious". Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Accordingly, the combinations of claimed elements within claims 1-4 are believed to be patentable and the Examiner is respectfully requested to reconsider the aforementioned rejections and to allow claims 1-4.

Finally, the Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Morrey, et al. and Bonutti in further view of Lee et al. (5,693,030). Specifically, the Examiner states that the previously discussed combination of Morrey, et al. Bonutti teach all of the limitations found within claim 5, but for the obturator that may be extended in the tube for cleaning debris, which is argued by the Examiner to be taught by U.S. Patent No. 5,693,030 to Lee. The Examiner states that it would have

1 been obvious to a person of ordinary skill in the art at the time the invention was made
to combine these references in order to derive the invention as claimed. Applicant
respectfully disagrees. Claim 5 depends from claim 1 is believed to be allowable for at
least the reasons set forth hereinabove with respect to claim 1.

5 New claims 9-12 have been added and each ultimately depend from claim 1.
Accordingly, claims 9-12 are believed to be allowable for at least the reasons set forth
herein above with respect to claim 1. Claim 9 further adds a suction mechanism,
capable of generating a suction force, operatively coupled with the proximal end portion
of the tube. This structural arrangement, dictated by the limitations within claim1, is not
10 taught or otherwise suggested within the prior art. Claim 10 further includes the
limitation that the proximal end of said tube is shaped and sized to have a diameter
greater than an intermediate portion of said tube; said bend, adjacent the distal end of
said tube, and the proximal end of said tube being shaped and sized relative to said
15 tube to substantially prevent unintended removal of said sleeve from said tube. No
such structural arrangement is found in the relevant prior art. Claims 9-12 are believed
to be patentably distinct from the prior art and their consideration and allowance is
respectfully requested.


20 New claims 13-16 have been added and each ultimately depend from claim 8.
Accordingly, claims 13-16 are believed to be allowable for at least the reasons set forth
herein above with respect to claim 8. Moreover, the structural arrangements and
combinations specifically found within these claims are not taught or otherwise
suggested within the prior art. Accordingly, claims 13-16 are believed to be patentably

1 distinct from the prior art and their consideration and allowance is respectfully
requested.

5 In light of the above amendments and remarks, applicant asserts that the claims
are in condition for allowance. Applicant respectfully requests reconsideration and
allowance of the same.

No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,

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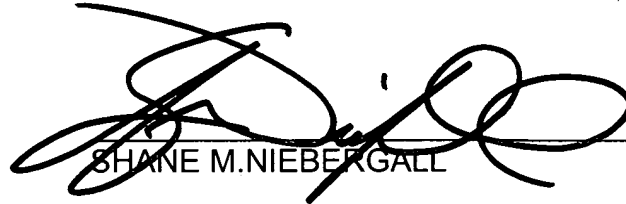
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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for R. MICHAEL GROSS, Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of December, 2005.



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